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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/816,023	03/23/2001	Joseph G. Englert	539P	8510

7590
Thomas M. Freiburger
P.O. Box 1026
Tiburon, CA 94920

06/07/2007

EXAMINER

BORLINGHAUS, JASON M

ART UNIT	PAPER NUMBER
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3693

MAIL DATE	DELIVERY MODE
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06/07/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/816,023	Applicant(s) ENGLERT, JOSEPH G.	
	Examiner Jason M. Borlinghaus	Art Unit 3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

The examiner for this application has changed. Please indicate Examiner Jason Borlinghaus as the examiner of record in all future correspondences.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 – 8 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See *MPEP* § 2172.01.

For example, Claim 1 claims a methodology comprising several enumerated steps. However, claim language fails to identify or recite any linkage or structural cooperative relationships between claimed steps.

Claims 1 - 10 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 – 10 are replete with indefinite and vague claim language, Examiner shall supply an illustrative sampling, although by no means exhaustive, of such 112 rejections.

Claims are replete with lack of antecedent basis problems. Claim 1, step (a), claims entering "information on the buyer in the proposed transaction". (emphasis

Art Unit: 3693

added). What buyer? Does buyer mean the exporter/customer or is the buyer a separate party? Doesn't exporter/customer mean a customer that is an exporter? Therefore, wouldn't an exporter be a seller and not a buyer? Claim 1, step (c), claims "the entered information". What entered information? The entered information in step (a) from the inquiry form or the entered information in step (c) from the solution work sheet?

Claim 1, step (b) states "evaluating risks of the transaction, both pre-export and post-export." Does the phrase "both pre-export and post-export" refer to the evaluation, as an evaluation takes place pre-export and post-export, or does the phrase refer to the evaluated risks, as the evaluation examines pre-export risks and post-export risks?

What are the metes and bounds of pre-export and post-export time frame? For example, does the pre-export time frame start before the actual physical shipment of the exported merchandise, during initial discussions between contracting parties or before any contact is made between parties? As another example, does the export timeframe conclude, entering a post-export phase, after merchandise has arrived at the importer or once payment has been received by the exporter?

What risks are being evaluated? From claim language, some particular risks (although claimed extraordinarily broadly) are recited as being included in the term "risks" but use of the word "including" indicates that such indicated risks are merely a partial component list and not exhaustive. Does the claim indicate that all risks are being evaluated? Such would seem to be an impossibility.

Claim 1, step (b), "including risks attendant to the nature of the transaction." (emphasis added). Such wording is vague and indefinite, as there can be an infinite

Art Unit: 3693

number of risks attendant to the nature of a transaction. For example, the merchandise being lost during delivery, non-payment for merchandise, foreign exchange fluctuations, or international war are could all be risks attendant to the nature of the transaction.

Claim 1, step (c1), claims "using a list of financial tools to review to review possible pre-export and post-export credit tools" (emphasis added). Possible is vague and indefinite, as such is highly subjective. There could conceivably be an infinite number of possible credit tools. A list of financial tools to review credit tools, is that correct? Assumedly, the list is not doing the reviewing but the financial tools on the list are doing the reviewing. But regardless, one tool is reviewing another tool?

Please examine all pending claims and, where required, correct appropriately.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1 – 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker (US PG Pub. 2002/0095355) in view of Disclosed Prior Art (applicant's specification, pp. 1 – 3) and **Official Notice**.

Regarding Claims 1 – 8, Walker discloses a method for use in gathering, evaluating, planning and estimating risks and costs of financing an export transaction, comprising:

- (a) entering onto an inquiry form (GUI) information (company and individual information; transaction information). (see para. 78, 80, 82 and 99);
- (b) evaluating risks of the transaction (costs and risks), both pre-export and post-export, including risks attendant to the nature of the particular transaction (risk of regulatory non-compliance), risk involved in obtaining payment to the exporter/customer (non-payment and non-collection), and risks attendant to financing of the entire transaction (non-payment and non-collection). (see para. 22);
- (c) entering information (company and individual information; transaction information) into a solution work sheet (GUI). (see para. 78, 80 82, and 99);
- (c1) using a list of financial tools (six basic methods) to review possible pre-export and post-export credit tools for financing (such as credit card, pre-paid escrow arrangement, letter of credit...) the export transaction. (see para. 99);
- (c3) selecting financing tools (one of six basic methods) for the transaction, both pre-export and post-export, and entering projected structural costs and

transaction costs (all process costs and expenses) on the solution work sheet (GUI) as tentative costs for a course of action using the selected tools. (see para. 97 - 99);

(c5) preparing a term sheet (pro forma invoice) which contains a finance proposal (financing terms) including the tools (six basic methods) selected in step (c3) for the export transaction. (see para. 99 – 109);

- further including an additional step (d) of entering (updating) information on actual costs of the financing transaction as the transaction goes forward onto a cost comparison sheet (commercial invoice transaction template). (see para. 108 – 109); and
- performed by a lender (third party service provides), and wherein Step (b) includes evaluating performance risks of the exporter/customer, related to the payment record of the exporter/customer (business verification, business credit reporting service, business reference checks and confirmations). (see pp. 81).

Walker does not teach the entering of specifically claimed information into an inquiry form, solution worksheet, financial tool price sheet, evaluation sheet or transaction cost review sheet. However, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The claimed steps would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability. see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir.

1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); *In re Ngai*, F. 3d, 2004 WL 1068957 (Fed. Cir. May 13, 2004).

Walker does not teach evaluating risks up to the point at which loss passes to the buyer; entering information into a worksheet divided in pre-export and post-export sections; calculating structural and transactional costs based upon financial tools, and determining lender revenue therefrom; calculating cost ratio; nor comparing actual costs/cost ratio with projected costs/cost ratio.

Disclosed Prior Art discloses a method comprising:

- (c) entering information divided into pre-export and post-export time and events (such as during estimating of pre-export and post-export risks and costs of the financing). (see p. 1, line 24 – p.2, line 2);
- (c1) using a list of financial tools (financial tool options) to review possible pre-export and post-export credit tools for financing the export transaction. (see p. 2, lines 8 - 21);
- (c2) entering information on a financial tool price sheet, as to the structural cost and the transaction cost of using each of a plurality of pre-export tools listed on the list of financial tools (price sheets for various selectable financing tools), and a plurality of post-export tools listed on the list of financial tools, and determining lender revenue for each of the various alternatives. (enable the lending officer to fully analyze all risks and costs to the customer/exporter as well as revenue portions to the lending institution). (see p. 2, lines 8 – 21);

Art Unit: 3693

(c3) selecting financing tools for the transaction (one of the financial tool

options), both pre-export and post-export, and entering projected structural costs and transaction costs on the solution work sheet (gathering together...various costs). (see p. 2, lines 8 – 21);

(c4) calculating total structural costs and total transaction costs for the

transaction (including costs incident only to the particular transaction and structural costs), adding such costs (gathering together...various costs) and determining a total cost ratio for the financing of the transaction (via cost ratio work sheets), calculated as total costs including structural and transaction costs, divided by the total transaction amount, (total cost ratio of financing costs against total transaction amount). (see p. 2, lines 2 – 25); and

(c5) evaluating (analyze/calculate) the total cost ratio, making a decision

whether the cost ratio is acceptable. (see p. 2, lines 2 – 25).

Examiner takes **Official Notice** that contractual language, either explicitly stated or implied by law, concerning the time at which risk of loss passes between contractual parties, such as a seller and a purchaser; calculation of a cost ratio in connection with a transaction or investment to service as a financial benchmark; and comparison of actual costs/ratios with projected costs/ratios for monitoring of financial performance or accounting purposes are old and well known in the art of business transactions and financial management.

Art Unit: 3693

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Walker to incorporate financial tools, analysis of the financial implications of such financial tools and application of a performance benchmark to the transaction, as disclosed by Disclosed Prior Art, allowing for parties to a transaction to properly assess the involved costs of said transaction and assess the financial cost-benefit of said transaction.

It would have been obvious to one of ordinary skill in the art at time the invention was made to have modified Walker and Disclosed Prior Art to incorporate such methodologies and technologies as are old and well known in the art, as such methodologies and technologies are standard and conventional in the art of business transactions and financial management.

Regarding Claims 9 – 10, such claims recite similar limitations as claimed in previously rejected claims, would have been obvious based upon previously rejected claims, or are otherwise disclosed by the prior art applied in previously rejected claims. Such claim limitations are therefore rejected using the same art and rationale as previously utilized. Applicant is reminded that any argument contrary to such an interpretation is an indication of patentably distinct subject matter that may warrant a restriction requirement.

Examiner's Note: The Examiner has cited particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the

Art Unit: 3693

specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Response to Arguments

Applicant's arguments and amendments, filed 3/2/2007, with respect to the rejection of Claims § 101 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn.

However, upon further consideration, a new ground(s) of rejection is made based upon Walker (US PG Pub. 2002/0095355) in view of Disclosed Prior Art (applicant's specification, pp. 1 – 3) and **Official Notice**.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Borlinghaus whose telephone number is (571) 272-6924. The examiner can normally be reached on 8:30am-5:00pm M-F.

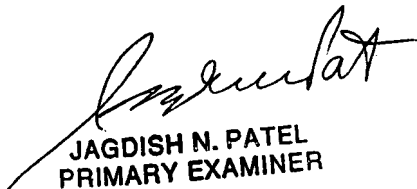
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3693

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMB

May 29, 2007



JAGDISH N. PATEL
PRIMARY EXAMINER